



AF/3711/\$

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Mark Yoseloff

Examiner: V. Mendiratta

Serial No. 09/520,402

Group Art Unit: 3711

Filed: March 8, 2000

Docket No. PA0437.ap.US

Title: POKER GAME WITH PARLAY BET

**BOX: AF APPEALS**

Assistant Commissioner for Patents  
Washington, D.C. 20231


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**The following documents are hereby submitted:**

- ☒ Appeal Brief to the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office (three copies)
- ☒ Authorization to withdraw \$155.00 to cover Appeal Brief Fee of a small entity.
- ☒ Transmittal Sheet
- ☒ Return postcard

**Please consider this a PETITION FOR EXTENSION OF TIME for sufficient number of months to enter these papers if an additional extension of time is deemed necessary by the Office. Authorization is hereby given to charge Deposit Account Number 50-1391 if such additional extension is necessary.**

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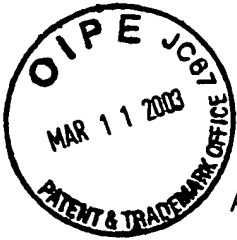
By:   
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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: Assistant Commissioner for Patents, Box AF Appeals, Washington, D.C. 20231 on March 6, 2003.

Mark A. Litman  
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Serial No. 09/520,402                      Group Art Unit: 3711  
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APPEAL BRIEF TO THE BOARD OF  
PATENT APPEALS AND INTERFERENCES OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

BOX AF (Appeals)  
Commissioner of Patents and Trademarks  
Washington, D.C. 20231

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TECHNOLOGY CENTER R3700

Sir:

This is an appeal from the Office Action mailed on November 4, 2003 finally rejecting claims 1-37, all the claims in the Application.

This Brief is being filed in triplicate along with authorization to debit \$320.00 to Deposit Account No. 50-1391 to cover the fee for the appeal. Appellants request the opportunity for a personal appearance before the Board of Appeals to argue the issues of this appeal. The fee for the personal appearance will be timely paid upon receipt of the Examiner's Answer.

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on March 6, 2003.

Mark A. Litman  
Name

Signature

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## TABLE OF CONTENTS

### Page No.

Real Party in Interest.....	3
Status of Claims.....	4
Status of Amendments.....	5
Summary of the Invention.....	6
Issues in the	
Appeal.....	7
Related Appeals and Interferences .....	8
Grouping of Claims.....	9-11
Response to the Rejection. ....	12-24
Conclusion.....	25
Appendix.....	26-33

**REAL PARTY IN INTEREST**

The real party in interest is the assignee, Shuffle Master , Inc. d/b/a Shuffle Master Gaming, a corporation organized under the laws of the State of Nevada, having a principal place of business at 1109 Palms Airport Drive, Las Vegas, Nevada, 89119-3730.

### **STATUS OF CLAIMS**

All claims in the Application have been finally rejected as follows:

- 1) Claims 1-19 and 22-37 have been finally rejected under 35 U.S.C. 103(a) as unpatentable over Williams in view of Ornstein ('885).
- 2) Claim 20 has been finally rejected under 35 U.S.C. 103(a) as unpatentable over Netley in view of Ornstein.
- 3) Claims 1, 4, 15, 20, 23 and 31 have been finally rejected under the Judicially Created Doctrine of Obviousness-Type Double patenting.

### **STATUS OF AMENDMENTS**

No Amendments were filed to the claims after final rejection, all previous amendments to the claims have been accepted without comment. The checking of Box No. 7 in the PTO-303 form mailed January 31, 2003 has no substantive meaning as no Amendment to the specification or claims was submitted in the Response to the Final Rejection filed on 6 January 2003.

### **SUMMARY OF THE INVENTION**

A casino table card game or video counterpart of that card game begins with a player placing a wager to participate in the game. The wager may be in three distinct parts. (Page 7, lines 10-11 and 28-29). At least two different card hands are provided to the player with the faces of the cards hidden. (Page 7, lines 11-12). When there are three bets, the first bet establishes the wager amount for play of a first game (the first hand), the second bet establishes the wager amount for the play of a second game (the second hand), and the third bet establishes the wager amount for a parlay event involving both the first hand and the second hand. (Page 7, lines 12-15)

The first hand is played to conclusion of the first game, and then the player may elect to forfeit one of the remaining wagers (as when there was no winning event with the first hand), or continue play of the second hand and place both the second and third bet amount at risk. (Page 7, lines 17-19). When both the first hand and the second hand attain a minimum predetermined rank in the play of the first game and the second game, there is a special payout on the parlay bet. (Page 7, lines 19-21)

### **ISSUES ON APPEAL**

The generic issues on Appeal are whether all claims in this Application directed to the invention are obvious under 35 USC 103(a); and whether claims 1, 4, 15, 20, 23 and 31 are directed to subject matter properly rejected under the Judicially-Created Doctrine of Obviousness-Type Double Patenting.

The specific issues in the Appeal under 35 U.S.C. 103(a) include at least:

- a) The sequence of steps recited in the claims on appeal cannot be obvious when individual steps in the combination are not taught by any reference in the combination of references under 35 U.S.C. 103(a).
- b) When the sequence of steps in the claims on appeal excludes a step that is essential to practice of the prior art, the claimed invention cannot be obvious under 35 U.S.C. 103(a) since amending the prior art would destroy essential elements of that invention.

The specific issues in the Appeal under the Judicially-Created Doctrine of Obviousness-Type Double Patenting include at least:

- a) When the prior art added to the claims of the parent application of the Application on Appeal fails to teach difference between the claims of the parent application and the claims on Appeal, the rejection under this doctrine must fail.



### **RELATED APPEALS AND INTERFERENCES**

Appellants do not know of any other pending U.S. Patent Applications that are on appeal which have issues that overlap with the issues in this Appeal. No Interference proceedings before the U.S. Patent and Trademark Office are known by Appellants to have any substantive relationship to the subject matter of this Appeal.

### **GROUPING OF CLAIMS**

The following grouping of claims is made in compliance with the requirements of 37 C.F.R. 1.191 for the content of an Appeal Brief. The following grouping of claims is made to expedite this Appeal and narrow issues, and is not intended to waive or limit the right of the Applicants to enforce and defend claims separately, even though they are grouped for convenience in this Appeal.

#### **Under the Rejection of Claims Under 35 USC 103(a), Appellant groups the claims solely for the purposes of this Appeal as follows:**

Claims 1, 2 and 20-21 shall stand or fall with the patentability of claim 1 under the issue of obviousness under 35 U.S.C. 103(a)

Claim 3 shall stand or fall alone under the issue of obviousness under 35 U.S.C. 103(a). This claim provides for different the minimum ranks of the first and second hands determining the payout amount.

Claims 4-11 shall stand or fall with the patentability of claim 4. These claims distinguish from the limits of claim 1 at least for the reason of using decks of cards in the provision of symbols.

Claims 12-14 shall stand or fall with the patentability of claim 12. These claims recite that there must be three distinct wagers and apportions each wager to specific elements of play among the two hands of cards.

Claims 15 and 16 shall stand or fall with the patentability of claim 15 under the issue of obviousness under 35 U.S.C. 103(a). The claims are specific to a video game embodying the rules of the underlying parlay poker game.

Claims 17 and 18 shall stand or fall with the patentability of claim 17 under the issue of obviousness under 35 U.S.C. 103(a). These claims recite that there must be three distinct wagers and apportions each wager to specific elements of play among the two hands of cards.

Claim 19 shall stand or fall by itself under the issues of 35 U.S.C. 103(a). This claim provides a specific pay table for the individual hand play and for the parlay poker play.

Claims 22-25 and 29 shall stand or fall with the patentability of claim 22. This claim broadly claims the use of segments in games as the underlying play events in the parlay game.

Claim 26 shall stand or fall by itself under the issues of 35 U.S.C. 103(a). This claim recites specific limitations that distinguish it from all earlier claims, the use of reel slot games as the underlying games in the parlay event.

Claim 27 shall stand or fall by itself under the issues of 35 U.S.C. 103(a). This claim recites specific limitations that distinguish it from all earlier claims, the underlying game requiring that a player's hand beat a dealer's hand.

Claim 28 and 30 shall stand or fall with the patentability of claim 28 under the issues of 35 U.S.C. 103(a). This claim recites specific limitations that distinguish it from all earlier claims, this claim providing a rule wherein the lowest rank of the two hands determining the award for the parlay wager.

Claim 31 shall stand or fall by itself under the issues of 35 U.S.C. 103(a). This claim recites specific limitations that distinguish it from all earlier claims, the claim providing an alternative description of the play of the game.

Claims 32 and 36 shall stand or fall with the patentability of claim 32 under the issues of 35 U.S.C. 103(a). This claim recites specific limitations that distinguish it from all earlier claims, wherein play is limited to a single bet.

Claims 33 and 34 shall stand or fall with the patentability of claim 33 under the issues of 35 U.S.C. 103(a). This claim recites specific limitations that distinguish it from all earlier claims, wherein the payout tables for the first hand and the second hand are the same.

Claims 35 and 37 shall stand or fall with the patentability of claim 35 under the issues of 35 U.S.C. 103(a). This claim recites specific limitations that distinguish it from all earlier claims, wherein the payout tables for the first hand and the second hand are different.

With Respect to the Rejection of Claim 20 Under 35 U.S.C. 103(a) Over Netley in View of Ornstein

Claim 20, being the only claim in this rejection, shall stand or fall by itself.

With Respect to the Rejection of Claims 1, 4, 15, 20, 23 and 31 Under the Doctrine of Obviousness-Type Double Patenting

Claims 1, 4, 15, 20, 23 and 31 shall stand or fall with the patentability of claim 1 under this rejection.

**ARGUMENTS OF APPELLANT - RESPONSE TO THE REJECTIONS**

**Rejections Under The Judicially Created Doctrine of Obviousness-Type Double**

**Patenting over (Unspecified) Claims of U.S. Patent No. 6,471,208 in view of Ornstein**

Claims 1, 4, 15, 20, 23 and 31 have been rejected under a purported Judicially  
5 Created Doctrine of Double Patenting over the claims of U.S. Patent No. 6,179,711 in  
view of Ornstein. Appellants have offered to provide a Terminal Disclaimer, and that  
offer remains in the application. However, the rejection itself is in error and must be  
reversed.

10 **Claims 1, 4 and 10 shall stand or fall with the patentability of claim 1 on this issue**

Claim 1 of U.S. Patent No. 6,179,711 is:

1. A method of scoring a video wagering game, the game comprising at least a  
first and second segment, the method comprising the steps of:
  - 15 placing a wager to participate in a video wagering game;
  - playing the first segment of the video wagering game;
  - continuing play of the first segment until at least one predetermined  
condition has been met;**
  - 20 assigning a payout based on at least one winning outcome of the first  
segment;
  - playing the second segment of the video wagering game when the at  
least one predetermined condition has been met;
  - wherein said payout of the first segment is enhanced by a factor  
determined by an outcome in the second segment, and wherein the factor is  
at least one;
  - 25 multiplying the payout of the first segment by the factor determined  
in the second segment; and
  - paying the enhanced payout to the player.

This rejection is not understood, as the games recited in the present claims are quite  
30 distinct from the elements of the method recited in the claims of U.S. Patent No.  
6,179,711. Significant elements of the Patent claim that are not present in the play of the  
present method (in any claims) are highlighted.

The highlighted portions are not present in the recited method because:

- continuing play of the first segment until at least one  
predetermined condition has been met;**

1) There is no predetermined condition that is a condition precedent for any additional play, as recited in the Patent claim.

**playing the second segment of the video wagering game when the at least one predetermined condition has been met;**

2) The second hand is always dealt and is always played in the presently claimed method. There is no condition precedent of "playing...when the at least predetermined condition has been met." The second set of symbols or the second game is always played.

**wherein said payout of the first segment is enhanced by a factor determined by an outcome in the second segment, and wherein the factor is at least one;**

3) The second game does not determine factors. The second game (e.g., the second set of symbols or second hand) is independently awarded on the basis of its rank according to the pay table. No factor is determined.

**multiplying the payout of the first segment by the factor determined in the second segment;**

4) There is no multiplication of the first award by a factor determined in the second game event. The first payout is not multiplied. That amount is paid out (resolved in step a) by itself. The other events are separately paid out.

It is absolutely clear that the two processes (of the patented claims and the present claims) do not overlap and that the differences are not made obvious by Ornstein. The present claims could not have been recited in the Patent, as the present claims are a distinct invention not even within the generic scope of the claims of the Patent, and the subject matter of the present process was not disclosed in the specification of the patent.

The teachings of Ornstein, even as proffered by the rejection do not teach the differences between the claims of U.S. Patent No. 6,471,208. Ornstein is used to teach "...a method of playing a game where a payoff is made for consecutive winnings (col. 2, lines 17-21)." (Page 4 of Final Rejection mailed 4 November 2002) In addition, the play of U.S. Patent No. 6,471,208 is more distinct from the play of the present claims than is the "difference taught by Ornstein."

In particular, Ornstein is offered as teaching awards for consecutive wins, while claim 1 recites:

“...resolving the at least one bet with respect to whether a) the first set of symbols exceeds a minimum rank in the payout table; b) the second set of symbols exceeds a minimum rank in the payout table; and c) both the first set of symbols and the second set of symbols exceed a minimum in the payout table.”

5 This step is completely distinct from the claims of U.S. Patent No. 6,471,208 where winning in a first event brings up a distinct multiplier game. There is no win provided on each distinct play (steps a and b) and an additional win based on both hands exceeding a minimum rank on a pay table. The play in the claims of U.S. 6,471,208 is nearly  
10 irrelevant to the play recited in claims 1, 4, 15, 20, 23 and 31 in this Appeal. Therefore, any suggested modification purported to be obvious from the claims of this Patent Reference must radically alter the nature of play of this patent and must be motivated by specific details for specific purposes. Ornstein fails to do this.

Ornstein teaches play of a game **without ranks in the play of the various games**  
15 (craps, roulette, and baccarat) where a player places two bets and receives a single hand. One bet is on the underlying game, and the second bet is on consecutive wins (not contemporaneous hands with minimum ranks set out on pay tables). If the underlying bet is won, that bet is paid off and the consecutive bet wager remains in play. The player must then make a separate bet on a separate game, and if the player then wins the second  
20 game, the player is paid for having consecutive wins. Although “poker” is incidentally mentioned (column 6, lines 32-37), there is no mention of exceeding minimum ranks. As all games mentioned are games played against the house, the weak statement of “poker” must be assumed to be equivalent in play to the other games and be played against the house (player’s hand versus dealer’s hand). There is no mention of rank.

25 Thus, it is difficult to even attempt to combine the claims of U.S. 6,471,208, which have nothing to do with consecutive wins except for establishing a multiplier in a second bonus event for wins in an underlying game (without a payout for the bonus that is distinct from the awarded multiplier) with the play of Ornstein. The association

proposed in the rejection has no motivation, and even if literally combined, the combination does not practice the subject matter of claim 1

Additionally, all of these claims recite a limitation equivalent to:

“...without having placed an additional bet to the at least one bet;...”

- 5 This step is completely distinct from the required play of Ornstein which, by the very nature of the wagers being placed on consecutive games, requires that wagers be placed consecutively, and not have a single wager bet (even in a number of parts) during the entirety of the game.

- To combine the two references (the claims of U.S. Patent No. 6,471,208) and  
10 Ornstein to assert obviousness of these claims, it becomes necessary to destroy the underlying play of each of the games and distort the combined parts of the two different game formats into something that resembles neither. This combination cannot establish obviousness under any doctrine. The rejection is in error and must be reversed.

15 **Rejections Under 35 USC 103(a)**

Claims 1-19 and 22-37 have been rejected under 35 USC 103(a) as unpatentable over Williams in view of Ornstein (US Patent No. 5,570,885). It is asserted that Williams teaches every limitation of the claims except for “resolving a bet with respect when both first and second set of symbols exceed a minimum rank in the pay table.”

- 20 It is asserted that as Ornstein teaches a method of playing a game where a payoff is made for consecutive winnings, one of ordinary skill in the art would have made the Williams game more attractive for players by making an additional payoff for winning two or more plays consecutively. It is therefore asserted that it would have been obvious to modify the game of Williams to allow for the enhanced play taught by Ornstein.

- 25 Claim 20 has been finally rejected under 35 USC 103(a) as unpatentable over Netley in View of Ornstein. It is asserted that Netley shows every element of the claimed invention except for “paying for a parlay or consecutive winnings on hands.” It then is asserted that as Ornstein teaches a wagering game allowing a player to win multiple bets



for consecutive winning hands, it would be obvious to modify the game of Netley to allow for the enhanced play taught by Ornstein.

**Rejection of Claims 1-19 and 22-37 Under 35 USC 103(a) As Unpatentable Over**

5 **Williams In View of Ornstein**

Claims 1, 2 and 20-21 shall stand or fall with the patentability of claim 1 under the issue of obviousness under 35 U.S.C. 103(a)

10 This rejection is in error, even if the references are combined in the manner proposed by the Examiner. Each of these claims contains essentially the same limitations:

“...placing at least one bet...” or “...placing at least a one part bet...”; and  
“...playing a second wagering game segment whose outcome is based at  
15 least in part on chance without placing further wagers in addition to the wager comprising at least one part...” (or the least one bet).

The significance of this difference is that Ornstein requires that a second bet be placed **after the play of the first hand and before play of the second hand, so that the limitation of playing a second wagering game segment...without further placing wagers in addition to the at least one part IS NOT TAUGHT BY WILLIAMS IN VIEW OF ORNSTEIN.** Note for example, column 4, lines 26-32 where Ornstein states:

20 { “After the play of the first hand and assuming that the player making the bets in Fig. 3a has a winning hand, a streak chip S, which is under the control of the dealer, is placed in region C2 by the dealer. The player’s original bet is paid off and **the player then makes another original bet preparatory to the initiation of the second play,** as shown in Fig 3b.”  
25 (emphasis added)

Additionally, the play of the game remains the same (including originating wagers in each game) with each variety of game played, as stated by Ornstein on column 5, lines

51-56; and column 6, lines 25-32. In every description of the games, the play of the underlying game remains the same for the same game, which includes the originating bet in the game, whether the first game or the second game.

Ornstein therefore clearly teaches away from the specific limitation that Appellant asserts for patentability with respect to the limitations in the independent claims recited above, the requirement that no additional bet be made. As Ornstein specifically teaches that a second bet is to be made prior to play of the second game, the reference, either alone or in combination with Williams, does not teach the actual limitations of the claims.

10     Additionally, Ornstein does not maintain a sense of the relative rank of hands, and  
in fact never mentions rank as a basis for payment. The only mention of Poker is incidental (column 6, lines 32-37) and never discusses play against a pay table. This is an essential element of play in the present game and is recited in the claims, and is the basis for payment of the parlay event. The parlay is not paid for merely winning, but for both hands exceeding a minimum rank against a payable. The very nature of the game recited  
15 in the claims on Appeal requires that both hands remain displayed on the table at the conclusion of the two games (so that both hands may be compared to respective pay tables and the combined hands be compared to a payable), while the games as described by Ornstein are generally played one hand at a time and the table cleared before beginning the second game. Additionally, none of the games described in detail by  
20 Ornstein (baccarat, craps and roulette) have anything akin to ranks and do not mention pay tables. The brief mention of poker, without reference to ranks and play against a pay table renders that incidental remark insignificant as a teaching to grossly modify the play of Williams and the play of Ornstein.

25     There is no reasoned basis of how or why the play of those games should be modified to become the games recited in the claims. The substantive limitations of the elements of the game recited in the claims are not taught by either reference. It is impossible to create the game recited in the claims when there is no basis for finding those individual parts in the teachings of the references.

There is no basis for finding the use of only a single wagering step in the teachings of the references when there are three bet resolution considerations. There is no basis for finding that there should be three bet resolutions on two hands considered at the same time. The invention as a whole is not obvious from the teachings of the references, alone or in combination.

The rejection of claims 1-19 and 22-37 as unpatentable Williams in view of Ornstein is therefore clearly in error.

Claim 3 shall stand or fall alone under the issue of obviousness under 35 U.S.C. 103(a). This claim provides different the minimum ranks of the first and second hands determining the payout amount.

As noted above, the combination of references fails to teach even the consideration of ranks and pay tables for those ranks in the determination of winning events in the play of the underlying consecutive games of Ornstein. It is clearly not obvious to use different paytables for payments on ranks in contemporaneously resolved games according to these claims.

Claims 4-11 shall stand or fall with the patentability of claim 4. These claims distinguish from the limits of claim 1 at least for the reason of using decks of cards in the provision of symbols.

These claims are further distinguishable according to the issues of claim 1 by the fact that all games according to these claims must be played with playing cards and that ranks must be considered in determining winning events, and that three wager resolutions are made on the basis of the rank of two hands. These claims are patentable for all of the reasons that claims 1 and 2 were patentable and for the further limitation of ranks having to be made with playing card hands.

Claims 12-14 shall stand or fall with the patentability of claim 12. These claims recite that there must be three distinct wagers and apportions each wager to specific elements of play among the two hands of cards.

5 The combination of Williams in view of Ornstein is not obvious for the reasons that claims 1, 2 and 4-11 are not obvious, and for the reason that three wagers must be made simultaneously as the at least one wager, to which no further wagers may be added. The play of Ornstein and the nature of the games played in the disclosure teach only that two initial wagers are to be placed and that a third wager may be later placed, if the first hand wins and the second wager remains in play. There is no teaching of the obviousness  
10 of the sequence of play in these claims from those instructions of the prior art used in the rejection.

Claims 15 and 16 shall stand or fall with the patentability of claim 15 under the issue of obviousness under 35 U.S.C. 103(a). The claims are specific to a video game embodying the rules of the underlying parlay poker game.

15 Claims 15 and 16 are patentable not only for the same reasons that claims 1 and 2 were argued to be patentable above, but also because the rules of those games are embedded in a video wagering game. Although Ornstein mentions the applicability of his technology to video gaming equipment (column 1, lines 6-10), the nature of play  
20 described for those games do not include contemporaneously displayed wins, but rather only consecutively displayed wins. The payouts for placement of the streak chips of Ornstein are independent of any ranks. There are no paytables, but only individual odds on streaks. (Column 2, lines 39-55)

25 Claims 17 and 18 shall stand or fall with the patentability of claim 17 under the issue of obviousness under 35 U.S.C. 103(a). These claims recite that there must be three distinct wagers and apportions each wager to specific elements of play among the two hands of cards.

Again, as this claim recites that there are three initial wagers, that no further wager may be placed, and that each wager is separately evaluated and then jointly evaluated for wins, there is no teaching of the practice of this limitation in the art used in the rejection.

5

Claim 19 shall stand or fall by itself under the issues of 35 U.S.C. 103(a). This claim provides a specific pay table for the individual hand play and for the parlay poker play.

There is no showing of this specific payable, and there is no showing of the use of three contemporaneously considered paytables for two hands. There is absolutely no basis for asserting the obviousness of this claim.

10

Claims 22-25 and 29 shall stand or fall with the patentability of claim 22. This claim broadly claims the use of segments in games as the underlying play events in the parlay game.

These claims are patentable for the same reasons argued with respect to claims 1, 2 and 20-21. These claims also allow for the first and second games to be different games.

15

Claim 26 shall stand or fall by itself under the issues of 35 U.S.C. 103(a). This claim recites specific limitations that distinguish it from all earlier claims, the use of reel slot games as the underlying games in the parlay event.

20

There is no disclosure in Ornstein that would allow or teach for the underlying games to be reel slot games.

Claim 27 shall stand or fall by itself under the issues of 35 U.S.C. 103(a). This claim recites specific limitations that distinguish it from all earlier claims, the underlying game requiring that a player's hand beat a dealer's hand.

25

Even with poker versus a dealer's hand being played, there is no teaching in Williams in view of Ornstein that allows for a single wager to be placed, with no

additional wagers allowed for the second segment or the consecutive play segment of this claim.

5 Claim 28 and 30 shall stand or fall with the patentability of claim 28 under the issues of 35 U.S.C. 103(a). This claim recites specific limitations that distinguish it from all earlier claims, this claim providing a rule wherein the lowest rank of the two hands determining the award for the parlay wager.

10 Appellant cannot conceive of how this limitation is to be found in the teachings of the combination of references. There is no rank considered in the winning of hands, there is no comparison made between consecutive hands or their rank, and there is no payable based upon the rank of hands or the minimum rank of a pair of hands. There is absolutely no basis for finding that these limitations are obvious or taught by Williams in view of Ornstein.

15 Claim 31 shall stand or fall by itself under the issues of 35 U.S.C. 103(a). This claim recites specific limitations that distinguish it from all earlier claims, the claim providing an alternative description of the play of the game.

20 This claim is patentable not only for all of the reasons given above for the patentability of claims 1, 2 and 20-21 (except for the requirement of only a single wager placing step), but also for the specificity of these claims with respect to requiring different paytables for comparison of the first set of symbols, the second set of symbols, and the rank of both hands with a third payable. There is absolutely no basis from the teachings of the references of this concept.

25 Claims 32 and 36 shall stand or fall with the patentability of claim 32 under the issues of 35 U.S.C. 103(a). This claim recites specific limitations that distinguish it from all earlier claims, wherein play is limited to a single bet.

This set of claims adds the requirement for the at least one wager to be only a single bet (which may be in component parts), excluding subsequent wagers.

Claims 33 and 34 shall stand or fall with the patentability of claim 33 under the issues of 35 U.S.C. 103(a). This claim recites specific limitations that distinguish it from all earlier claims, wherein the payout tables for the first hand and the second hand are the same.

In addition to the requirements made with respect to the patentability of claim 31 where paytables are consulted for the first and second set of symbols and then a third table for comparison of the symbol sets, this claim requires that the first and second tables are the same. There is no basis for consideration of this limitation in the objective teachings of Williams in view of Ornstein. There can be no obviousness of this claim from the teachings of the references.

Claims 35 and 37 shall stand or fall with the patentability of claim 35 under the issues of 35 U.S.C. 103(a). This claim recites specific limitations that distinguish it from all earlier claims, wherein the payout tables for the first hand and the second hand are different.

In addition to the requirements made with respect to the patentability of claim 31 where paytables are consulted for the first and second set of symbols and then a third table for comparison of the symbol sets, this claim requires that the first and second tables are different. There is no basis for consideration of this limitation in the objective teachings of Williams in view of Ornstein. There can be no obviousness of this claim from the teachings of the references.

#### Rejection of Claim 20 Under 35 USC 103(a) Over Netley in View of Ornstein

It is asserted that Netley shows every element of the claimed invention except for “paying for a parlay or consecutive winnings on hands.” It then is asserted that as Ornstein teaches a wagering game allowing a player to win multiple bets for consecutive winning hands, it would be obvious to modify the game of Netley to allow for the enhanced play taught by Ornstein.

Netley does not show every element of the claims (the claim that is believed to be the broadest claim of this application, Claim 1, will be examined in this light), except for the parlay wager. In fact, Netley shows a traditional parlay type wager that is excluded

from play of the present game. A side-by-side comparison of Netley and the claimed play (with comments) would be helpful in detailing the differences.

Claim 1 of Application	Netley Disclosure	COMMENTS
1. A method of playing a wagering game with at least two consecutive plays comprising:	Netley has consecutive plays only after a win in a first hand and an election to wager on a second, bonus-type round.	The preamble requires the underlying game to have at least two consecutive hands. There may not be only an optional or bonus play.
Placing at least one bet;	At least one bet is placed.	Same step
receiving at least one first set of symbols from which a rank may be determined in reading the symbols;	Netley receives a hand of cards from which a rank may be determined.	Same step
determining the rank of the first set of symbols;	A rank is determined.	Same step
comparing the first set of symbols to a payout table;	A payout table is used to determine an amount of win	Same step
determining whether the rank of the first set of symbols exceeds a minimum rank in the payout table;	A minimum rank on the payout table is determined in comparison with the hand.	Same step
receiving at least a second set of symbols from which a rank may be determined without having placed an additional bet;	Netley provides a second hand only with a "win" in the first hand.	This step is a required, not optional step in the invention. Even with a win in Netley, this is optional. Without a win, there is no second hand.
determining the rank of the second set of symbols;	A rank is determined in the second hand.	Same Step
comparing the rank of the second set of symbols to a payout table;	A payout table is used to determine an amount of win	
determining whether the rank of said second set of symbols exceeds a minimum rank in the payout table;	A minimum rank on the payout table is determined in comparison with the hand.	
resolving the at least one bet with respect to whether a) the first set of symbols	The first bet of Netley is resolved with respect to the first set of symbols and the	It is important to note that a distinct bet is made by Netley for the first hand



exceeds a minimum rank in the payout table;	first pay table.	<b>and second hand. If the player wins the first hand, he can “either accept payment...or....wager the amount on a second tier poker hand. Col. 1, lines 45-52.</b>
b) the second set of symbols exceeds a minimum rank in the payout table;	<b>The distinctly separate second bet of Netley is resolved with regard to the second set of symbols.</b>	<b>The claims of the invention require that the at least first bet is resolved with regard to the second set of symbols.</b>
and c) <u>both</u> the first set of symbols and the second set of symbols exceed a minimum in the payout table.	There is no third resolution in Netley. There are at most two resolutions on two hands. Payout for the first hand and payout for the second hand.	<b>This concept of three payouts is absent from Netley. Netley is literally no more than a true parlay series of play, with an election of the amount to parlay.</b>

Ornstein does not cure the deficiencies of Netley. Ornstein merely describes a side bet game on the occurrence of consecutive wins in a base game, such as the game of blackjack. It does not require the player to participate in a second game without having placed an additional bet, and it does not provide an additional bonus payout for wins on

5 both base games.

**CONCLUSION**

All rejections of record have been shown in detail to be in error. The rejection should be reversed and all claims should be indicated as allowable.

Applicants believe the claims are in condition for allowance and request  
5 reconsideration of the application and allowance of the claims. The Examiner is invited  
to telephone the below-signed attorney at 952-832-9090 to discuss any questions that  
may remain with respect to the present application.

10

Respectfully submitted,  
MARK L. YOSELOFF

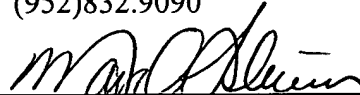
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Date 6 MARCH 2003


By

  
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Box AF, Assistant Commissioner of Patents, Washington, D.C. 20231 on March 6, 2002.

Name: Mark A. Litman

  
Signature

## APPENDIX - THE CLAIMS ON APPEAL

1. A method of playing a wagering game with at least two consecutive plays  
5 comprising:  
    placing at least one bet;  
    receiving at least one first set of symbols from which a rank may be determined in  
reading the symbols;  
    determining the rank of the first set of symbols;  
10 comparing the first set of symbols to a payout table;  
    determining whether the rank of the first set of symbols exceeds a minimum rank  
in the payout table;  
    receiving at least a second set of symbols from which a rank may be determined  
without having placed an additional bet to the at least one bet;  
15 determining the rank of the second set of symbols;  
    comparing the rank of the second set of symbols to a payout table;  
    determining whether the rank of said second set of symbols exceeds a minimum  
rank in the payout table;  
20 (resolving the at least one bet with respect to whether a) the first set of symbols  
exceeds a minimum rank in the payout table; b) the second set of symbols exceeds a  
minimum rank in the payout table; and c) both the first set of symbols and the second set  
of symbols exceed a minimum in the payout table.

2. The method of claim 1 wherein the resolution of the bet with respect to  
25 whether the first set of symbols and the second set of symbols exceed a minimum rank in  
the payout table requires that the rank of both the first set of symbols and the second set  
of symbols both exceed a minimum rank in the payout table for the resolution of the bet  
on c) to provide a return on the bet.

3. The method of claim 2 wherein the minimum rank of the ranks of the first set of symbols and the second set of symbols determines the amount of any payout for resolution of the bet on c).

5 4. A method of playing a wagering game of cards with at least two consecutive hands of a card game being played comprising:

placing at least one bet;

receiving at least one first hand of cards from which a rank may be determined;

determining the rank of the first hand of cards;

10 comparing the first hand of cards to a payout table;

determining whether the rank of the first hand of cards exceeds a minimum rank in the payout table;

receiving at least a second hand of cards from which a rank may be determined without having placed an additional bet to the at least one bet;

15 determining the rank of the second hand of cards;

comparing the rank of the second hand of cards to a payout table;

determining whether the rank of said second hand of cards exceeds a minimum rank in the payout table;

97 resolving the at least one bet with respect to whether a) the first hand exceeds a

20 minimum rank in the payout table; b) the second hand exceeds a minimum rank in the payout table; and c) both the first hand of cards and the second hand of cards exceed a minimum in the payout table.

25 5. The method of claim 4 wherein all hands are dealt from a deck of playing cards.

6. The method of claim 5 wherein the deck of playing cards is a standard deck of fifty-two cards.

7. The method of claim 4 wherein all ranks are determined as poker ranks.
8. The method of claim 5 wherein all ranks are determined as poker ranks.
- 5 9. The method of claim 6 wherein all ranks are determined as poker ranks.
10. The method of claim 4 wherein all minimum ranks are at least one pair.
- 10 11. The method of claim 5 wherein all minimum ranks are at least one pair.
12. The method of claim 4 wherein said at least one bet comprises three bets, one allocated towards a), one allocated towards b), and one allocated towards c).
- 15 13. The method of claim 10 wherein said at least one bet comprises three bets, one allocated towards a), one allocated towards b), and one allocated towards c).
14. The method of claim 11 wherein said at least one bet comprises three bets, one allocated towards a), one allocated towards b), and one allocated towards c).
- 20 15. A method of playing a video wagering game with at least two consecutive hands of a card game being played comprising:
- placing at least one bet;
- receiving at least one first hand of cards from which a rank may be determined;
- 25 determining the rank of the first hand of cards;
- comparing the first hand of cards to a payout table;
- determining whether the rank of the first hand of cards exceeds a minimum rank in the payout table;

receiving at least a second hand of cards from which a rank may be determined without having placed an additional bet to the at least one bet;

determining the rank of the second hand of cards;

comparing the rank of the second hand of cards to a payout table;

5 determining whether the rank of said second hand of cards exceeds a minimum rank in the payout table;

resolving the at least one bet with respect to whether a) the first hand exceeds a minimum rank in the payout table; b) the second hand exceeds a minimum rank in the payout table; and c) both the first hand of cards and the second hand of cards exceed a  
10 minimum in the payout table.

16. The method of claim 15 wherein all ranks are determined as poker ranks.

17. The method of claim 15 wherein said at least one bet comprises three bets,  
15 one allocated towards a), one allocated towards b), and one allocated towards c).

18. The method of claim 16 wherein said at least one bet comprises three bets, one allocated towards a), one allocated towards b), and one allocated towards c).

20 19. The method of claim 15 wherein the payout table comprises:

<u>Outcome</u>	<u>First Game</u>	<u>Second Hand</u>	<u>Parlay Bet</u>
Royal Flush	250	250	5,000
Straight Flush	50	50	5,000
Four Aces	160	160	5,000
25 Four 2's, 3's, or 4's	80	80	5,000
Four 5's - Kings	50	50	5,000
Full House	10	10	400
Flush	7	7	100
Straight	5	5	50

Three-of-a-kind	3	3	9
Two Pair	1	1	5
One Pair	1	1	3

- 5           20. A method of playing a wagering game of poker comprising:
- a) a player wagering on a first game of poker;
  - b) the player playing said first game of poker;
  - c) determining if the player wins the first game of poker;
  - d) if the player wins the first game of poker with a hand exceeding an at
  - 10           least predetermined rank, providing the player with an opportunity to play
  - a second game of poker without placing further wagers; and
  - e) if the player attains a hand in the second game of poker that also
  - exceeds said predetermined rank, a payout is achieved for a) the rank of
  - the first poker hand, b) the rank of the second poker hand, and c) the
  - 15           occurrence of both the first poker hand and the second poker hand
  - exceeding a specific rank.

21.       The method of claim 20 wherein a side bet must be placed to allow the
- player to receive the bonus payout and the side bet must be wagered prior to step a).
- 20

22. A method of playing a wagering game comprising:
- placing at least a one part bet;
  - playing a first wagering game segment whose game outcome depends
  - 25           at least in part upon the random selection of game symbols;
  - comparing a first segment game outcome to the rules of the game to
  - determine if a payout is associated with the first segment game outcome;

playing at least a second wagering game segment whose outcome depends at least in part upon the random selection of game symbols without placing further wagers; and

comparing a second segment game outcome to the rules of the game to determine if a payout is associated with the second segment game outcome

awarding the player a first payout when the first segment game outcome is determined to be a winning outcome;

awarding the player a second payout when the at least a second game outcome is determined to be a winning outcome; and

when consecutively played first and at least second game segments both have winning outcomes, paying the player a third payout for the consecutive winning outcomes without having placed further wagers other than the at least a one part bet.

23. A method of playing a wagering game comprising:

a player placing a wager comprising at least one part to participate in the wagering game;

playing a first wagering game segment whose game outcome depends at least in part upon chance;

comparing a first segment game outcome to the rules of the game to determine if a payout is a winning outcome;

playing a second wagering game segment whose outcome is based at least in part on chance without placing further wagers in addition to the wager comprising at least one part; and

comparing the outcome of the second segment game to the rules of the game to identify whether the outcome is a winning outcome; and

awarding the player a separate payout for winning outcomes of the first wagering segment game and winning outcomes of the second



wagering segment game, and where there are consecutive winning outcomes for the first wagering segment game and the second wagering segment game, awarding the player a third payout without placing further wagers in addition to the wager comprising at least one part.

5

24. The method of claim 23 wherein the first and second wagering segment games are identical games.

25. The method of claim 24 wherein the first and second wagering segment  
10 games are poker.

26. The method of claim 24 wherein the first and second wagering segment games are reel slot games.

15 27. The method of claim 23 wherein the rules of the wagering game require that the player's outcome must outrank a dealer's outcome to have a winning outcome for the player.

28. The method of claim 23 wherein the rules of the games of the first and  
20 second wagering segment games includes a plurality of ranked outcomes, and wherein the third payout is based on the lowest ranking outcome of the first and second wagering segment games.

29. The method of claim 23 wherein the bet is a three part bet.  
25

30. The method of claim 28 wherein all parts are equal

31. A method of playing a wagering game with at least two consecutive plays required in each game comprising:

placing a first bet;

receiving at least one first set of symbols from which a rank may be determined in reading the symbols;

determining the rank of the first set of symbols;

comparing the first set of symbols to a first payout table;

determining whether the rank of the first set of symbols exceeds a minimum rank in the first payout table;

receiving at least a second set of symbols from which a rank may be determined;

determining the rank of the second set of symbols;

comparing the rank of the second set of symbols to a second payout table;

determining whether the rank of said second set of symbols exceeds a minimum rank in the second payout table;

resolving the first bet with respect to whether a) the first set of symbols exceeds a minimum rank in the first payout table; b) the second set of symbols exceeds a minimum rank in the second payout table; and c) both the first set of symbols and the second set of symbols exceed a minimum in a third payout table.

32. The method of claim 31 wherein the first bet is the only bet.

33. The method of claim 31 wherein the first payout table and the second payout table are the same.

34. The method of claim 33 wherein the third payout table is different from the first payout table and the second payout table.
35. The method of claim 31 wherein the first payout table and the second payout table are different.
36. The method of claim 32 wherein the first payout table and the second payout table are the same.
37. The method of claim 36 wherein the third payout table is different from the first payout table and the second payout table.